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EXAMINER	
KING, ANITA M	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/910,655
Filing Date: July 20, 2001
Appellant(s): LIEBENDORFER, JOHN E.

Ray R. Regan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 14, 2005.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1, 3, 4, 6-10, 17-19, 21, 31, 32, 34, and 37.

Claims 2, 11, 33, 39, and 40 have been canceled.

Claims 5, 12,-16, 20, 22, 23, 35, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 24-30 are withdrawn from consideration as not directed to the elected invention.

Claims 38 and 41-49 are allowed.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Claims 31, 32, 34, and 37 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,349,912 to Schauss, et al. ("Schauss Patent").

(7) Claims Appealed

Claims 1-49 contain(s) substantial errors as presented in the Appendix to the brief. Accordingly, claims 1, 3, 4, 5-16, 17-23, 31, 32, and 34-37 are correctly written in the Appendix to the Examiner's Answer.

(8) Prior Art of Record

5,957,568	BYERS	9-1999
6,349,912	SCHAUSS et al.	2-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 4, 6-10, 17-19, and 21 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,957,568 to Byers. Byers discloses a system for removably and adjustably mounting a device (30) on a surface, comprising: a rail (10, 40) formed with at least two tracks (14, 16, 52); wherein the at least two tracks are removably mountable on a footing grid (the plurality of elements 80 in Fig. 3 which are a mounting member disposed under a plurality of shingles 98); a plurality of keepers (80, 104) on which to mount *the at least two tracks;* wherein the at least two tracks include a

channel extending the length of the rail; one or more clamps (64, 74, 102) for connecting; wherein the channel in the at least two tracks is formed with a slot extending the length of the rail; wherein the slot is formed at substantially right angle to the slot in any other of the at least two tracks (the slot of track 52 is formed at a right angle to the slots of tracks 14 and 16); wherein the one or more clamps is formed as a duct with at least two opposing flanges; wherein the opposing flanges of the one or more clamps are substantially perpendicular to one another (see Fig. 10); wherein the one or more clamps is formed with a leg having a base (112), a descending member (below reference number 116) monolithically extending from the base, and an ascending member (110) monolithically extending from the base in a direction substantially opposite the direction of the descending member; wherein the one or more clamps included means for connecting the device to the rail; wherein the one or more clamps is formed with a plate and monolithic opposing side walls extending substantially in the same direction at substantially right angles to the plate; wherein the opposing side walls include a lower inner edge and an upper face, and a fin extending from the upper face substantially along the longitudinal axis of the at least one dual track rail; and wherein the one or more clamps includes means for variably positioning the one or more clamps.

Claims 31, 32, 34, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,349,912 to Schauss et al., hereinafter, Schauss. Schauss discloses a system for removably and adjustably mounting a device on a surface, comprising: a rail (1) formed with at least two tracks; wherein the at least two tracks

include a slot formed at substantially a right angle to the slot in any other of the at least two tracks; wherein the rail is formed with a body having a proximal end, a distal end, and hollow chamber therebetween; one or more clamps (2) for connecting the system to the surface; wherein the at least two tracks includes a channel extending the length of rail; wherein the one or more clamps is formed as a duct with at least two opposing flanges; and wherein the one or more clamps is formed with a leg having a base, a descending member monolithically extending from the base, and an ascending member monolithically extending from the base in a direction substantially opposite the direction of the descending member.

(10) Response to Argument

In response to appellant's argument that a footing grid is not specified by the Byers reference, the examiner disagrees, according to appellant's specification (page 10, lines 2-5), the footing grid includes one or more footings and the footings compose a network of keepers; from this description it is apparent that the footing grid is formed by a plurality of keepers. The Byers reference teaches that reference character 80, i.e., a mounting member, is part of one of the plurality of shingles (98) in which the rail (10) is mounted thereon and reference character 104 is a gutter that is generally attached to a plurality of structural members and in which the rail (40) is mounted thereon. Thus, the limitation of a footing grid is met by Byers.

In response to appellant's argument that Byers does not disclose one or more clamps, the phrase "one or more clamps" is interpreted as either one or more than one clamp and the Byers reference teaches clamps (64, 74, or 102). The broadest

interpretation of the term "clamp" is defined as a device for joining or supporting structural or mechanical parts (Webster's II New Riverside University Dictionary, 1984, 1988, 1994). Based on this definition, the slid channel (64, 74, or 102) in Byers is used to define the clamp of appellant's claimed invention in the broadest sense; the clamp is joined with a track channel (44) and has flanges. Thus, Byers clearly meets this limitation.

In response to appellant's argument that the reference to Byers fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the rail being a solid core rail and the device (the module)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to appellant's argument that Byers teaches improvements in components for mounting decorative light strings to various mounting sites, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In response to appellant's argument that Byers does not disclose a slot extending the length of the rail and formed at substantially a right angle to the slot in any other tracks, from appellant's drawings, namely Fig. 4, the slot is depicted as the opening of the track/channel of the rail 12, the examiner contends that in Byers the track/channel are formed in the sides of the rail and the undersurface of the rail. These tracks all have openings and the side tracks are at right angles to the bottom track and thus, the limitation of the a channel (bottom channel) formed with a slot extending the length of the rail, and formed at substantially a right angle to the slot in any other tracks (side channels) is met by the Byers' reference.

In response to applicant's argument that Schauss is directed to a supporting structure especially for attachment to a robot arm and for securing tools, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In response to appellant's argument that Schauss does not teach a slot formed at substantially a right angle to the slot in any other of the at least two tracks, the rail (1) in Schauss (Fig. 4) shows a plurality of tracks/channels and wherein one channel (top or bottom channels) contains a slot formed at substantially a right angle to the slot in any

other of the channels (side channels), and thus, this limitation is indeed met by the reference to Schauss.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Anita M. King
Primary Examiner
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June 27, 2005

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CLAIMS APPENDIX

1. (Previously Presented) A system for removably and adjustable mounting a device on a surface comprising:

a rail formed with at least two tracks,

wherein the rails is removably mountable on a footing grid,

and further wherein the at least two tracks include a channel extending the length of the rail;

a plurality of keepers on which to mount the rail; and

one or more clamps for connecting the system to the surface.

3. (Previously Presented) A system for removably and adjustably mounting a device on a surface as recited in claim 1, wherein the channel in the at least two tracks is formed with a slot extending the length of the rail.

4. (Previously Presented) A system for removably and adjustable mounting a device on a surface as recited in claim 3, wherein the slot in one of the at least two tracks is formed at substantially a right angle to the slot in any other of the at least two tracks.

6. (Previously Presented) A system for removably and adjustably mounting a device on a surface as recited in claim 1, wherein the one or more clamps is formed as a duct with at least two opposing flanges.

7. (Previously Presented) A system for removably and adjustably mounting a device on a surface as recited in claim 6, wherein the opposing flanges of the one or more clamps are substantially parallel to one another.

8. (Original) A system for removably and adjustably mounting a device on a surface as recited in claim 1, wherein the one or more clamps is formed with a leg having a base, a descending member monolithically extending from the base, and an ascending member monolithically extending from the base in a direction substantially opposite the direction of the descending member.

9. (Original A system for removably and adjustably mounting a device on a surface as recited in claim 1, wherein the one or more clamps include means for connecting the device to the rail.

10. (Previously Presented) An apparatus for positioning a module on a surface, comprising:

a footing grid, wherein the footing grid includes at least one keeper;

at least one dual track rail removably mountable on the footing grid,

and further wherein the footing grid comprises means for variably positioning the at least one dual track rail on the at least one keeper; and

one or more clamps variably positionable on the dual track rail and footing grid for demountably securing the module to the footing grid.

17. (Original) An apparatus for positioning a module on a surface as recited in claim 10, wherein the one or more clamps is formed with a plate and monolithic opposing side walls extending substantially in the same direction at substantially right angles from the plate.

18. (Original) An apparatus for positioning a module on a surface as recited in claim 17, wherein the opposing side walls include a lower inner edge and an upper face, and a fin

extending from the upper face substantially along the longitudinal axis of the at least one dual track rail.

19. (Previously Presented) An apparatus for positioning a module on a surface as recited in claim 16, wherein the one or more clamps includes means for variably positioning the one or more clamps in the second channel, and for positioning the at least one keeper in the first channel of the at least one dual track rail.

21. (Previously Presented) An apparatus for positioning a module on a surface as recited in claim 10, wherein the one or more clamps is formed with a leg having a base, a descending member monolithically extending from the base, and an ascending member monolithically extending from the base in a direction opposite the descending member.

31. (Previously Presented) A system for removably and adjustably mounting a device on a surface, comprising:

a rail formed with at least two tracks,

wherein the at least two tracks include a slot formed at substantially a right angle to the slot in any other of the at least two tracks,

and further wherein the rail is formed with a body having a proximal end, a distal end, and a hollow chamber therebetween; and

one or more clamps for connecting the system to the surface.

32. (Previously Presented) A system for removably and adjustably mounting a device on a surface as recited in claim 31, wherein the at least two tracks include a channel extending the length of the rail.

34. (Previously Presented) A system for removably and adjustably mounting a device on a surface as recited in claim 31, wherein the one or more clamps is formed as a duct with at least two opposing flanges.

37. (Previously Presented) A system for removably and adjustably mounting a device on a surface as recited in claim 31, wherein the one or more clamps include means for connecting the device to the rail.